



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/734,563

12/12/2003

Joseph A. Sorge

10070615-01

2401

27495 7590 06/28/2011

Agilent Technologies, Inc. in care of:

CPA Global

P. O. Box 52050

Minneapolis, MN 55402

EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

NOTIFICATION DATE

DELIVERY MODE

06/28/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

Agilentdocketing@cpaglobal.com

Art Unit: 1652

Claim Objections

Claims 1-10 and 12-21 are objected to because of the following informalities:

Claims 1-7 are objected to because the claims recite V93 of SEQ ID NO:89” and also recite “corresponding residue ... from one of the other sequences of SEQ ID NOs. 83-108”. Thus applicant’s claims refer to SEQ ID NO:89 twice. Applicants traverse this objection on the basis that the offices interpretation of the claim is incorrect and the claims do not recite V93 of SEQ ID NO:89 twice. The objection is maintained for the reasons previously stated. At the very least the claim is awkward and confusing.

Claims 1-10 and 12-26 are objected to because the claims comprise non-elected subject matter.

Appropriate correction is required.

Claims 1-10 and 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 (claims 8-10 and 12-21 dependent from) were previously rejected under this statute for the recitation “an amino acid mutation at V93 in an amino acid sequence selected from one of SEQ ID No’s 83-108” being indefinite on the basis that SEQ ID NO:108 does not have an amino acid position V93. In response to this rejection applicants have amended the claims and argue this rejection as it applies to the newly amended claims.

Art Unit: 1652

Applicants continue to traverse this rejection on the basis that applicants specification presents a comparison of six polymerases all of which have a valine at residue at position 93 of the sequence. Applicants submit that an artisan would use a sequence alignment to determine the residue that corresponds to V93 of SEQ ID NO:89.

Applicants complete argument is acknowledged and has been carefully considered, however, is not found persuasive for the reasons previously presented.

It continues that while the corresponding of some sequence may be clear, there exist a number of sequences for which the corresponding amino acid residue is not clear. As previously stated, is the corresponding residue of the other sequences a valine residue or is it any amino acid at position 93 of these sequences. As previously pointed out and not addressed by applicants in SEQ ID NO:108 there is no V93. Is the corresponding residue V92, V99, or D93? Similar confusion results in examination of many of the other amino acid sequences also.

Claims 1-10 and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1652

This rejection was stated in the previous office action as it applied to previous claims. In response to this rejection applicants have amended the claims and argue the rejection as it applies to the newly amended claims

Applicants continue to submit that the previous amendment addresses the Office's concern as to the absence of a V93 residue in SEQ ID NO: 108 and applicants submit that all of their prior arguments with regard to enablement and the adequacy of the written description for the claimed mutants, within the context of currently examined SEQ ID NO: 108, are applicable to SEQ ID NO: 108, and that the Board's decision should be controlling to the extent that the Office further considers patentability of the claims under 35 U.S.C. § 112, first paragraph. Applicants further submit that residue 141 corresponds to V93 of SEQ ID NO:89. While applicants may have pointed out applicants intended residue of SEQ ID NO:108, it remains that applicants have not adequately described the breadth of the genus of claimed mutants.

Applicants amendment of the claims and applicants complete argument as well as the prior Board Decision are acknowledged and have been carefully considered, however, are not found persuasive for the reasons previously made of record and for those reasons repeated herein.

It continues that applicants have not adequately described those Archaeal DNA polymerases comprising a mutation at a position corresponding to V93 of SEQ ID NO:89 in the amino acid sequence of SEQ ID NO: 83-108. As previously stated, the specification, does not provide a single species of that polypeptide comprising the

Art Unit: 1652

amino acid mutation corresponding to V93 of SEQ ID NO:89, in an amino acid sequence of SEQ ID NO:108, on the basis that as discussed above, SEQ ID NO:108 does not comprise an amino acid position V93 and that position corresponding to V93 is indefinite. It is additionally noted that many additional sequence of SEQ ID NO:83-108 do not comprise a V93 or a residue corresponding to V93. (See above rejection under 112 second paragraphs). Thus there is no disclosure of any particular structure to function/activity relationship in the claimed species. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.